REMARKS

Claims 1, 2, 8, and 9 were previously pending in this application. Claims 1, 8, 16, and 21 are the pending independent claims. Claims 11-21 are new to this application.

Independent claims 1 and 8 have been amended to state that the material is coated with a coating composition selected from the group consisting of silver nano particles, titanium oxide photocatalyst, and mixtures thereof. Support for this amendment can be found at page 12, lines 9–13 of the application as originally filed.

Rejections Under 35 U.S.C. § 102(b)

Claims 1 and 8 are rejected under 35 U.S.C. § 102(b) as anticipated by Vanderlaan et al. (U.S. Pub. No. 2002/0197299).

Vanderlaan et al. describes a contact lens and lens case which require "activated silver" to inhibit the growth of bacterai. The Vanderlaan specification defines "activated silver" as "silver that has been incorporated into the polymer of a lens and subsequently activated by treatment with an oxidizing agent." (Vanderlaan et al. at ¶ [0009].) Vanderlaan et al. states that the oxidizing agent can be dispersed or dissolved in an aqueous solution and washing or soaking the contact lens with the oxidizing solution for 10 seconds to about 10 hours. (Vanderlaan et al. at ¶ [0009].)

While Vanderlaan et al. does mention nano-size powder, the nano-size silver is silver that must be subsequently activated. In contrast, the silver nano particles of the claimed invention is merely "activated" upon use, when the liquid in the lens case comes into contact with the container or insert to cause the silver nano particles to be rinsed from the surface of the container or insert and into the liquid.

Vanderlaan's activated silver does not describe coating silver or even activated silver onto the container or insert as claimed. Accordingly, the amended claims are novel over the Vanderlaan et al.

Rejections Under 35 U.S.C. § 103(a)

Claims 1, 2, 8, and 9 are rejected under 35 U.S.C. § 103(a) as obvious over Vanderlaan et al.

The Vanderlaan et al. container, insert, and contact lenses have a bacteriostatic effect (i.e., provide a means for sterilizing the container) while, in contrast, the claimed container and insert is effective to provide an antimicrobial effect to the contact lens being stored in the container.

The silver of Vanderlaan et al. is cast into the polymer of the object to be prepared. When cast in polymer, the amount of silver needed is significantly higher than the amount of silver nano-particles needed when the nano silver particles are coated onto the material surface as claimed. Thus, the materials of Vanderlaan et al. would not be capable of providing the effect of the claimed invention unless using very high amounts of activated silver. In the claimed invention, the silver nano particles are activated upon use, i.e., when liquid is added to the container as discussed above.

Thus, the claimed invention provides a solution which has a different effect than that provided by the cited reference. The claimed invention provides an antimicrobial container/insert while the cited reference provides a bacteriostatic container/insert. Also, the claimed invention is easier to produce because silver can be coated onto any premade material in contrast to being incorporated into the material itself. Accordingly, the amount of silver needed in the claimed invention is reduced as compared to the prior art. Despite the reduced amount of silver, the claimed invention has an effective amount of silver that is higher than that of the prior art due to the higher availability of silver on the surface.

The Commissioner is hereby authorized to charge any additional fees which may be required in this Application to Deposit Account No. 06-1135.

Respectfully requested,

FITCH, EVEN, TABIN & FLANNERY

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